

DOCKET NO. 03-SIN-094 (STMI01-03094)
SERIAL NO. 10/700,872
PATENT

REMARKS

Claims 1-25 are pending in the application.

Claims 1-25 have been rejected.

Claims 1-25 remain pending in this application.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1-4, 10-13 and 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,944,510 to *Ballesty, et al.* (hereinafter "Ballesty") in view of U.S. Patent Application Publication No. 2004/0093202 to *Fischer, et al.* (hereinafter "Fischer"). The Applicants respectfully traverse the rejection.

Claims 5-6, 14-15 and 22-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Fischer reference and the Ballesty reference in view of U.S. Patent No. 5,890,187 to *Asghar* (hereinafter "Asghar") and further in view of U.S. Patent No. 5,774,851 to *Miyashiba, et al.* (hereinafter "Miyashiba"). The Applicants respectfully traverse the rejection.

Claims 7, 16 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Fischer reference and the Ballesty reference in view of the Miyashiba reference. The Applicants respectfully traverse the rejection.

Claims 8, 17 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Fischer reference and the Ballesty reference in view of U.S. Patent No. 5,845,247 to *Miyasaka* (hereinafter "Miyasaka"). The Applicants respectfully traverse the rejection.

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In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

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disclosure. MPEP § 2142.

Claim 1 recites an apparatus that includes:

at least one parameter identifier operable to receive the cross-correlated signal and identify a plurality of parameters associated with at least one of the first and second audio signals using the cross-correlated signal.

The Office Action notes that the Ballesty reference fails to disclose this element of Claim 1.

The Office Action then attempts to cure this deficiency by suggesting that paragraph [0048] of the Fischer reference discloses the claimed identifier. However, paragraph [0048] of the Fischer reference actually states:

[0048] Two signatures can be compared by measuring the distance between their optimal alignment. In general, the choice of the metric used depends on the orientation of the quantized density slices with respect to the time, frequency, and energy axis of the energy density. Examples for such distance measures are given in the description of the two embodiments of the invention. A decision rule with a separation value depending on the metric is used to distinguish identical from non-identical recordings.

First, the Fischer reference does not disclose an identifier that is operable to receive a cross-correlated signal as required by Claim 1. The Fischer reference only discloses receiving two signatures, neither of which is a cross-correlated signal. Second, because the Fischer reference does not receive a cross-correlated signal, the Fischer reference cannot be said to use a cross-correlated signal to identify a plurality of parameters associated with at least one of first and second audio signals as required by Claim 1. Instead, the Fischer reference simply discloses that the two signatures are compared by measuring the distance between their optimal alignment. Measuring the distance between the optimal alignment of the two signatures does not anticipate identifying a

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plurality of parameters associated with at least one of first and second audio signals using a cross-correlated signal.

The Final Office Action asserts that "signatures are a plurality of parameters". Even if one were to interpret the signatures as the plurality of parameters, the Fischer reference still does not disclose using a cross-correlated signal to identify the signatures.

Therefore, at least this element of independent Claim 1 (and independent Claims 10 and 18) is not taught or suggested by the Fischer reference or the Ballesty reference, alone or in any motivated combination. As such, all claims include elements not taught or suggested by any art of record, alone or in combination, and so all obviousness rejections are traversed.

Accordingly, the Applicants respectfully request the Examiner to withdraw the § 103 rejection with respect to these claims.

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CONCLUSION

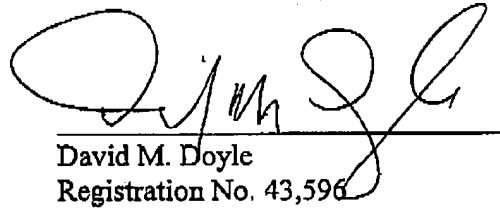
As a result of the foregoing, the Applicants assert that the remaining claims in the application are in condition for allowance and respectfully request that this application be passed to issue.

If any issues arise or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *ddoyle@munckbutrus.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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